

Remarks/Arguments**(s.102(b) rejection) of Claims 1-4, 8, 9, 11-13 over Wolpert**

In the Office Action, the Examiner rejects claims 1-4, 8, 9, and 11-13 under 35 U.S.C. 102(b) as being anticipated by Wolpert in US1,560,456 ("Wolpert"). In particular, the Examiner states that Claims 1, 2, 4, 8, 9, 11 and 12 are "clearly anticipated", additionally that "shank 15" in Wolpert may be considered the "locator" in Applicant's claims 3 and 13, and finally that rubber plug 16 may be a weight in the same way as applicant's.

Applicant respectfully disagrees for the reasons set forth below:

- a. In addition to the arguments made in our last correspondence (December 2002), we note that Wolpert's tube 3 is of even diameter and is NOT tapered, as required in applicant's claims. We therefore respectfully submit that Wolpert does not anticipate applicant's claims.

In particular, applicant submits that its inventive method of "locating" the weight and/or stiffening pieces is by matching the outside diameter of the necessarily tapered cue tip section at the desired location of the placement of the weight or stiffener, in order to thereby fit the weight or stiffener *and thus locate the same* at the pre-determined location. This will not work without a taper to the inside diameter of the cue's tip segment.

We submit that the amendment proposed to claims 3, 10 and 13 make the distinction clearer, by replacing "by a locator" with "by matching the tube's inner diameter at the desired placement within the tube with the augmenting element's outer diameter".

- b. With respect to the Examiner's assertion that Wolpert's rubber insert 16 when viewed as a weight is located by threaded shank 15, applicant argues that Wolpert's "soft rubber bar or plug" (line 95) insert 16 is primarily a cushion, and is "located" by being fitted by compression (line 96) into tube 3, and that the trunnion 15 is pressed into the soft rubber plug in order that vibration from the cue's very tip is transmitted through trunnion 15 to the soft rubber plug to effect its primary function as vibration damper. The fact that the pliable plug 16 (line 100) is primarily for dampening vibration and noise and only secondarily adds weight is made clear. Additionally, the pliable plug of Wolpert is not user-refittable to adjust weight, balance and other characteristics of the cue's tip in a customizable way. The threaded shank 15 is therefore not a "locator" in the sense of holding a weight or stiffener at a set distance from the cue tip section's small end.
- c. The arguments in paragraph b., above, are made having regard to the Examiner's comments in rejecting claims 3 and 13. As well, the Examiner's comments as regards claim 8 do not show anticipation, in the sense that Wolpert's pliable plug 16 is not "secured", but merely fitted by compression within the tube 3 (Wolpert line 95-96). In applicant's case, as the tube is of necessity tapered, fitting a pliable plug by compression would be susceptible to later

movement from the tip toward the butt end due to the gradually widening diameter of the tube's interior, so pliable rubber plugs fit by compression would not be suitably "secured" as required by applicant's claim 8.

It is noted that Wolpert contemplates non-resilient or sound-absorbing material (line 104), which teaches that the plug 16 is for vibration-reduction and not for customizing weight and balance. None of these features either anticipate or describe the solution taught by the Applicant's invention namely inserting and locating a weight at a customizable place within the interior of a hollow metallic tapering tubular cue tip section.

For these reasons, applicant submits that the Examiner's rejection of claims under 35 USC 102(b) in view of Wolpert is incorrect.

(s.102(b) rejection) of Claim 5 over Barrett

The Examiner suggests that tube 27 in Barrett is a single piece which with element 26 providing stiffening and weight and therefore anticipates applicant's claim 5. Applicant respectfully disagrees, and makes the following arguments:

- d. Barrett teaches the construction of a cue tip section (at least) made of a hollow tube of Bakelite or similar non-metallic plastic composite 27 (line 65 et seq.), and reinforced by an inner hollow metallic tube 26. The inner tube 26 is required as the non-metallic composite material is not sufficiently strong as to be self-supporting, and the metallic inner reinforcing tube is required to be in contact with the cue's soft tip (or the mount for that tip) and the cue's butt in order that the tube 27 support compression and other loads, as the outer tube (casing) 27 is not on its own capable of doing so. In that regard, Barrett requires an outer plastic casing 26 and an inner reinforcing metal tube 27 while applicant requires only a tapered hollow single-piece metal tube with suitable surface, capable of self-support.

For clarification, applicant has amended claims 1, 10 and 11 by substituting "walls capable of self-support and of carrying required physical loads arising during use" for the words "walls capable of self-support".

It is to be stressed that Barrett's tube 27 is of non-metallic material, while applicant's is necessarily of metallic material.

Furthermore, claims 1, 10 and 11 have also been amended to emphasize that the tube in applicant's case is of necessity metallic by adding the word "metallic" between the words "hollow" and "tube" in claims 1, 10 and 11. Claims 3, 10 and 13 are also altered by replacing "by a locator" with "by matching the tube's inner diameter at the desired placement within the tube with the augmenting element's outer diameter".

(s.103(a) rejection) of Claims 6 and 7 as obvious in light of Willson

In the Office Action, the Examiner states that Wilson's tip section b is equivalent to applicant's hollow metallic tube, and that Wilson's fastening bolt e is equivalent to applicant's stiffening member. Applicant disagrees, and respectfully submits the following argument:

- a. Wilson's part e is conceived of as a through-bolt extending from its head, which is countersunk in part c and made integral with the cue's soft striking tip (which is also thus made removable by being unscrewed from the cue), and passes through the entire tip section to the through-bolt's other end, which is threaded to a nut and tightened to hold a threaded tip-to-butt mounting piece to the tip section. The part e is not a stiffener, and is not optionally added or removed, tailored to customize the cues' behavior, but is rather a fastener for the cue's soft-tip and for the cue's tip's tip-to-butt mounting component. In contrast, Applicant's stiffening member adds stability or stiffness as well as to counter flex or enable compressibility, to the tip-segment of the hollow metal cue tip's structure in a customizable way, and not to add convenient fastening functionality.

It is also noted that claims 6 and 7 depend from claim 5, which states that the stiffening member is secured to an interior position within the hollow tube, while Wilson's clearly extends past part b (tube) both to be embedded within the soft tip c and to the nut g past the mount h past the end of tube c. That is, we submit, due to the purpose of Wilson's part e as a fastener and not a stiffener. Additionally, the Wilson invention did not address the issue of user-customizable stiffness or compressibility.

- b. For clarity, applicant has amended claim 5 (and thereby claims 6 and 7) by adding the restriction "but not extending therethrough" to the end of claim 5.

Reconsideration of claims 6 and 7 in view of these remarks is therefore requested.

(s.103(a) rejection) of Claim 10 as obvious in light of Wolpert

In the Office Action, the Examiner states that Applicant's claim 10 insofar as it mentions "chrome-plated steel" as a suitable material, is obvious in light of Wolpert's claimed smooth exterior surface. Applicant continues to submit that the additional characteristics of Applicant's tubes being manufactured of a specific type of material with structural characteristics in addition to the desired polished exterior finish found in some chrome-plated steel tubing, are significantly different from Wolpert's cue material and design, and indeed in light of the Examiner's "judicial notice" of the smooth character of chrome-plated steel, and thus not obvious in the sense of s.103(a).

Chrome-plated steel tubing, in addition to having a smoothly finished exterior provides a suitable material, which is manufacturable to evenly-tapered dimensions capable of self-support, and to provide a suitable interior dimension to receive and mount, a weight, a stiffener and a mounting means, its inclusion does not form the basis for a s.103(a) rejection of Applicant's claim 10. This is particularly true in light of the amendments to the amended claims submitted herein.

In conclusion, it is respectfully submitted that the Examiner's rejections contained in the Office Action have been overcome, and that the Application is in a condition for allowance.

Respectfully submitted,
John W. Andrews

By: 

Andrew R. Hicks
Reg. No. 39,468
Borden Ladner Gervais LLP
1100 - 100 Queen Street
Ottawa ON K1P 1J9, Canada
Tel: (403) 232-9717
Fax: (403) 266-1395
E-mail: ipinfo@blgcanada.com

ARH/MRW/ldk/trn

Enclosure:

1. Marked Revised Claims